

REMARKS-General

By the above submitted amendment, applicant has rewritten claims 1-4, 7, 9 and 15-18 so as to overcome the technical rejections and define the invention patentably over the prior art.

OA issues #3 and #4

Pursuant to 37 CFR 1.111 (b), applicant requests that objections and requirements as to form not necessary to further consideration of the claims 1-7 and 11-16 be held in abeyance until allowable matter is indicated in these claims.

Claims rejection under 35 USC 112

OA issue #5

Claims 1-15 were rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention. It would be not clear how the invention can work if a buffer is secured to only one of the arms as in claims 1 and 2.

The specification describes page 11, lines 23-39 how a clamp according to the invention can work when it is used in case a buffer is secured to each of the two arms. These arms can keep objects under pressure because they can lock against their support part by friction. But the specification also says page 1, lines 25-40, that clamps of the prior art such as made out of a straight support part and two bare arms, without any buffer secured to, can also work upon locking by friction. Actually the specification says that the role of the substantially elastic buffers is to improve the result of this working by replacing the hard contact of these bare arms against the objects under pressure by a supple one which can act as a compression spring because it is the external face of a thick layer of substantially elastic material (see specification page 10, lines 2-5). One of the results of this replacement is that an arm provided with such a buffer can conform to difficult shapes (see for example page 2, line 31). But there are other obvious advantages such as the ones which are characteristic of a compression spring like the resistance to vibrations, the possibility of compressing gradually which makes the clamp set up more progressive. In other words, the specification implicitly says that when there is only one buffer, only the contact on the side of the arm to which is secured the buffer will be improved but the principle of working of the tool will not be changed. Accordingly applicant requests reconsideration and withdrawal of this rejection.

OA issue #6

Claims 12-15 were rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the

time the application was filed, had possession of the claimed invention. Specifically, the support part being made of several parallel beams would not be supported by the original specification (cl. 12). Also, the buffer being split up into several pieces would not be supported by the original specification (cl. 13, 14). In addition, the connection between each of the arms and the support part being made by a stirrup would not be supported by the original specification (cl. 15).

Applicant requests reconsideration and withdrawal of this rejection, because it can be found stated in the original specification: page 29, lines 10-18, the support part being made of several parallel beams; page 29, lines 22-24 and following, the buffer being split up into several pieces; page 22, lines 19-24, the connection between each of the arms and the support part being made by a stirrup.

OA issue #7

Claims 1-18 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant requests reconsideration and withdrawal of this rejection, because all the following changes or explanations are submitted:

- (i) the wording "one at least" has been replaced by "at least one" in every claim where it was necessary, cl. 1-2, 9, 16-18,
- (ii) the wording "a so large thickness" has been turned into "a thickness large enough so" in cl. 1-2, 16-18,
- (iii) in claim 3, "said at least one substantially elastic buffer" has been reduced to "said substantially elastic buffer"
- (iv) in claim 4, to wording "so that they could overlap" has been added "each other, "all" has been replaced by "every", "the buffers of two first of said four arms" has been changed into "the buffers of the two first arms of said four ones" and "ould" has been replaced by "could".
- (v) in claim 7, the phrase "those of said two arms that are movable" has been replaced by "of said two arms those which are movable"
- (vi) in claim 15, "stirrup" has been replaced by "loop-shaped gland",
- (vii) in claim 16, "said method for holding objects by clamping without any risk at all of damaging" has been reduced to "said method" while the phrase "for holding objects by clamping without any risk at all of damaging" has been moved to the beginning of the claim,
- (viii) in claims 17 and 18, "said movable arm" has been turned into "said at least one movable arm" lines 3 and 5, and it is submitted that "said arms" in step (e) have a proper antecedent basis in claim 16, upon which these claims are dependent (see line 3 of claim 16).

Claims 1-3 and 11-16 rejection under 35 USC 103 as being unpatentable over Neff in view of Thornton

With regard to the proposed combination of Neff and Thornton, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art §103 rejection, *the references themselves* (or some other

prior art) must suggest that they be combined. E.g. as was stated In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

"Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipement Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

"It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

Neff and Thornton Do Not Contain Any Justification To Support Their Combination. Much Less In The Manner Proposed

There is nothing in the prior art, including Neff and Thornton, that suggests to combine these references. So there is no reason to combine them, the more so since each of the references of the prior art is complete and functional in itself. These references take mutually exclusive paths to reach different solutions to a similar problem and therefore by implication each teaches away from combining itself with the other.

Neff teaches a clamping device with arms which can slide parallel to each other along a straight support part with a means for exerting the clamping force which looks very like the combination of a shoulder and its humerus in the human body. On the opposite, Thornton teaches a plier of which one arm can be distanced from the other one only by adjustment along a secondary branch of the handle which supports it. There is no support part along which the arms can slide. And the means that Thornton teaches for exerting the clamping force is in contrast a V-shaped spring. He teaches in addition pads which are made of a soft material like rubber but extend only slightly out of the arms to which they are secured (see page 4, lines 16-18 of Thornton), i.e. have a small thickness.

It would be necessary to make severe modifications, not taught in the prior art, to combine the references in the manner suggested by the O.A.. Everything is round-shaped in Neff. Everything is square-shaped in Thornton. And as there is no intrinsic means in applicant's invention for exerting the clamping force (since this one is provided by user's hands), such a means should be arbitrarily taken off from Neff whereas it was intentionally provided for.

And even if combined in the manner the O.A. proposes, the references would not show all the novel physical features of claims 1-3 and 11-16.

Everyday experience (for example with a shoe sole) clearly shows that a small thickness of a soft material does not behave as a compression spring but just as a contact softener. Whereas applicant's invention explicitly provides in claims

1-18 at least one buffer behaving as a compression spring.

It is no more suggested in the prior art that the support of Neff could be made of several beams connected together by couplers as claimed in claim 11 and that the elastic buffer could be split up into pieces. Only hindsight gleaned from the invention itself could suggest it and that would be quite improper to render obvious said invention this way as it was stated in Uniroyal Inc.. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

[W]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...*Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*"

Moreover, the result achieved by applicant's invention, that is to say providing a clamp which can conform to difficult shapes (see affidavit filed on 1995 June 16) is greater than the sum of the respective results of the individual references because none of these ones can achieve such a result individually. That is why applicant requests reconsideration and withdrawal of claims 1-3 and 11-16 rejection on Neff and Thornton under 35 USC 103.

The Rejection Of Claims 4-6 On Neff, Thornton and Berna is Overcome

First of all, this combination is also improper because nothing in the prior art, including Neff, Thornton and Berna, suggests to combine these references. So there is no reason to combine them, the more so since each of the references of the prior art is complete and functional in itself. These references take mutually exclusive paths to reach different solutions to a similar problem and therefore by implication each teaches away from combining itself with the other. Berna teaches a clamping device of which the arms are placed along a straight support but where the means for exerting the clamping force is a longitudinal coil spring. In the variant under consideration in the O.A., Berna teaches that with two couples of arms, it is possible to clamp a first set of objects with one of the two couples and then another set of objects with the other couple of arms with two successive maneuvers of same handle. But these two couples of arms are to be maintained distanced from each other so that one of them could be clamped while the other one is maintained released by the handle. Besides two springs taking support against a central piece are repulsing in opposite directions along the support part the most internal arms of these couples which can slide whereas the most external arms are permanently locked by screws or the like against the support part. Moreover the arms must remain in a row along the support part.

The only similarity between this variant and applicant claim 4 are a straight support part and two couples of arms placed along it. But what claim 4 is reciting is that at least three (and not only two) of the four arms that comprise the two couples altogether are liable to slide along the support part; that these arms must turn around the support part and not remain in a row; further the arms of the couples can overlap each other, that is to say one arm

of a couple can be nearby and over the other arm of said couple whereas these arms can be at an angle to each other and their buffers oriented towards the other couple; and the other couple will do the same with approximately the same angle. And the result achieved by this claim is completely different from the one Berna is achieving. Instead of clamping two sets of objects each between two arms in a row, claim 4 is designed for clamping only one set of objects but between four arms, two arms on one side and two other ones on the other side, and on each side the two arms are approximately at the same angle to each other. Thus in view of claim 4, the reference Berna does not teach what the O.A. relies upon it as supposedly teaching. So applicant requests reconsideration and withdrawal of claim 4 rejection under 35 USC 103.

As claim 5 is dependent on claim 4, applicant requests the same for claim 5. Claim 6 recites three couples of arms along a straight support part which are independent from each other; two couples can be turnable around the support part so that they can be clamped individually buffer against buffer and be at an angle to each other; these two couples can then form two feet with which the opposite end of the support part can create a triangular base for the third couple of arms; in this way, this third couple can hold by clamping a set of objects above the bench upon which the triangular base is resting.

In contrast the variant of Berna which is considered in the O.A. teaches two couples of arms which must be dependent of each other; otherwise, the same handle could not activate them one after the other; and in addition, the four arms of these two couples must remain in a row. Thus also in view of claim 6, the reference Berna does not teach what the O.A. relies upon it as supposedly teaching. Accordingly, applicant requests reconsideration and withdrawal of its rejection under 35 USC 103.

Neff, Thornton and Ditto Can No More Be Combined Because They Do Not Contain Any Justification To Do So And Ditto Does Not Teach What The O.A. Relies Upon

For the reasons given above, the combination of Neff to Thornton and Ditto is also improper because nothing in the prior art, including these references, suggests to combine them. And each of the references of the prior art is complete and functional in itself. These references take mutually exclusive paths to reach different solutions to a similar problem and therefore by implication each teaches away from combining itself with the other.

Ditto teaches a clamp incorporating two opposed jaws having resilient pads; a first jaw is fixed at one end of a couple of spaced and parallel rods; the other jaw is slidably movable along these rods; and stops are provided at the other end of the couple of spaced and parallel rods. The O.A. states that these stops are removable. That is not specified in Ditto's patent. It is only said that these stops are called end caps and are designed to protect user's hand. But if they are to protect user's hands, they surely should not be removable; otherwise they could not perform permanently their function of protection: should they be removed inadvertently, user's hands would be exposed to hazard. Ditto allocates no other function to these stops.

Claim 7 of application recites a removable stop. So even if combined, the

references Neff, Thornton and Ditto would not meet claim 7. Accordingly, applicant requests reconsideration and withdrawal of its rejection under 35 USC 103.

#### Conclusion

For all of the above reasons, applicant submits that the claims all define patentably over the prior art. Therefore he submits that this application is now in condition for allowance, which action he respectfully solicits.

#### Conditional Request For Constructive Assistance

Applicant has amended the claims of this application so that they are proper, definite, and define patentably over the prior art. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. §707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully

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*Philippe BERNA*

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